

Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Initially, the Office Action Summary page does not indicate the status of claim 34, nor is this claim mentioned elsewhere in the Office Action.

In response to the rejection of claims 19 and 31 under the second paragraph of 35 U.S.C. §112, claim 19 has been amended to incorporate formula (I) and the definition for R¹ from claim 1; and claim 31 has been cancelled. These amendments render the rejection under 35 U.S.C. §112 moot.

Toward the end of November of last year, the Examiner left Applicants' Attorney a voicemail message indicating that claim 28 should not be directed to a pharmaceutical composition because the compound has agricultural use. In view of this, claim 28 has been amended to recite an antifungal composition for agricultural and gardening applications, which is based on the disclosure at page 26, lines 32-33 of the specification.

The rejection of claim 1 under 35 U.S.C. §102(b) as being anticipated by Shimano et al. is respectfully traversed.

In referring to page 12747 of this reference, which also is the AO reference in Applicants' IDS filed August 4, 2000, it appears the Examiner is applying the Shimano et al. reference entitled "Total Synthesis of the Antifungal Dilactones UK-2A and UK-3A: The Determination of their relative and Absolute Configurations, Analog Synthesis and Antifungal Activities", Tetrahedron 54 (1998) 12745-12774. Applicants note that the Office Action mailed February 26, 2001 included a rejection of claim 1 as being anticipated by this reference, specifically in item 5 on page 3 of that Office Action. In responding to the Office Action on August 27, 2001 Applicants filed a verified English translation of the priority application in order to avoid the use of the Shimano et al. reference as prior art against the present invention. In the next Office Action, mailed November 23, 2001, at the top of page 2, the Examiner withdrew the rejection based on the Shimano et al. reference (as well as other rejections). There were no subsequent rejections based on the Shimano et al. reference, until issuance of the present Office Action. Applicants again

respectfully submit that in view of the verified English translation of the Japanese priority application, having a filing date of February 6, 1998 (prior to the August, 1998 publication date of the Shimano et al. reference, this publication date being mentioned on page 3 of the Office Action of February 26, 2001), this reference is not available as prior art against the present invention. For this reason alone, Applicants take the position that the rejection of claim 1 as being anticipated by this reference should be withdrawn.

On page 3 of the Office Action, the Examiner objects to claims 9 and 10 because they are based on a rejected claim. However, please note that claims 9 and 10 are dependent on claims 20, 21 and 23, all of which the Examiner has indicated are allowable.

The objection to claims 14, 28 and 29 as being based on a rejected claim should also be withdrawn, because the rejection of claim 1 on which these claims depend (along with claims 20, 21 and 33) should be withdrawn as indicated above.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of objection and rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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October 30, 2006